

## REMARKS

### **A.     Status of the claims**

Claims 1-8, 10-11, 14, 17-18, and 20-24, of which claims 1, 7, and 14 are independent, are pending in the present application. In the Office Action mailed 4.7.03, the Examiner (i) objected to claims 21 and 23; (ii) rejected claims 23 and 24 under 35 U.S.C. § 112, second paragraph; (iii) rejected claims 1-8, 10, 14-15 and 17-20 under 35 U.S.C. §102(b); and (iv) rejected claim 11 and 21-24 under 35 U.S.C. §103(a).

As set forth, Applicants have amended claims 21 and 22 to define the term "i" within the claims as suggested by the Examiner. After careful review of the pending claims and the cited references, Applicants respectively request reconsideration in view of the following remarks.

### **B.     Examiner Interview**

Applicants gratefully thank Examiner Choi for the telephonic interview conducted on July 30, 2003. During the interview, Applicants and Examiner Choi discussed the claim limitations of "elongated tubular light source ... freely positioned within the automotive elongated semi-circular reflector," as in independent claim 1 and similarly in independent claims 7 and 14, and "an automotive half-circle reflector" and "a multi-faceted reflector" as in claim 7 and similarly in claim 14. The Examiner stated that these limitations would be reconsidered in view of the discussion.

Applicants contend that these claim limitations distinguish the present invention. For example, as discussed during the interview, Figure 5 (attached herein for the convenience of the Examiner) illustrates one example of a freely positioned light source as in the present invention.

In contrast, both cited references to Ishikawa and Nederpel disclose lighting devices where the light source is positioned immediately adjacent the reflector such that the light source actually touches the reflector. Applicants contend that neither Ishikawa nor Nederpel disclose a light

*Not the case*  
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source “freely positioned” within the lighting device. In addition, neither Ishikawa nor Nederpel suggest any teachings of a freely positioned light source. Each reference only teaches one embodiment of light source positioning, that is, to attach the light source to the reflector.

Further, during the interview, Applicants asserted that claims 21 and 23 were not obvious in view of Ishikawa. Applicants contend that Ishikawa in no way suggests the technique as claimed to engineer a reflector. The Examiner stated that the claim rejections of claims 21 and 23 would be reconsidered.

**C. 35 U.S.C. § 112 Claim Rejections**

Claims 22 and 24 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As set forth in the application as filed on page 5, lines 8-9, the Federal Motor Vehicle Safety Standards 571.108 (“FMVSS 108”), is entirely incorporated into the application thereby providing at least one standard for ascertaining the automotive signaling lighting requirements. Applicants contend that one skilled in the art of automotive lighting would clearly be reasonably apprised of the automotive signal lighting requirements.

**D. 35 U.S.C. § 102(b) Claim Rejections**

Claims 1-8, 10, 14-15, and 17-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ishikawa, U.S. Patent No. 5,584,572 (Ishikawa ‘572). Applicants submit that Ishikawa ‘572 does not teach (i) a freely positioned light source or (ii) a half-circle reflector and a multi-faceted reflector.

In contrast, Ishikawa ‘572 teaches a reflector which includes a rounded reflecting portion that *contacts* a portion of an outer surface of the light source (Ishikawa, Col. 1, lines 47-56 and

Col. 3, lines 9-19). Thus, Ishikawa '572 does not teach an elongated tubular light source freely positioned within a reflector as in independent claims 1, 7, and 14 of the present invention.

Further, as shown in Figure 1, Ishikawa '572 teaches a rounded portion 20 that is less than a half circle. Since the planar reflecting portion 22 composes a portion of the rounded portion 20 and extends over more than half of the light source, the rounded portion 20 is not half circular. On the other hand, if the planar reflecting portion 22 and the reflecting portion 20 are considered together to be a circular reflector, then Ishikawa '572 fails to teach a multi-faceted reflector as in claims 7 and 14. As a result, Ishikawa '572 does not teach *both* a half-circle reflector and a multi-faceted reflector as in claim 7 and similarly as in claims 1 and 14.

**E. 35 U.S.C. § 103(a) Claim Rejections**

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nederpel et al., U.S. Patent No. 5,735,595 (Nederpel '595) in view of Ishikawa '572. Claims 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishikawa '572. The Examiner is reminded that a determination under 35 U.S.C. § 103 should rest on all evidence and should not be influenced by any earlier conclusion. Thus, once the Applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. The Office should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings. Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings. (MPEP § 2144.08).

**1. Neither Ishikawa '572 nor Nederpel '595 teach or suggest all the limitations of the pending claims**

Neither Ishikawa '572 nor Nederpel '595 teach or suggest an elongated light source freely positioned within a reflector, as in pending claims 1, 7, and 14. As explained above,

Ishikawa '572 does not teach or suggest a freely positioned elongated light source since the rounded reflecting portion taught in Ishikawa **contacts** the light source (Ishikawa, Col. 1, lines 47-56). Similarly, Nederpel '595 fails to teach the present invention because Nederpel '595 teaches a lamp partly recessed within an elongate niche 13 of a housing 10, and "the lamp 1 is fastened in the niche 13 in a few spots with an adhesive 4." (Nederpel '595, Col. 3, lines 33-38, Figures 2-3). Thus, Nederpel '595 does not teach a freely positioned light source, but rather a light source that is glued in place.

In addition, neither Ishikawa '572 nor Nederpel '595 teach or suggest a half-circle reflector and a multi-faceted reflector, as in pending claims 1, 7, and 14. As explained, Ishikawa '572 fails to teach a half-circle and a multi-faceted reflector. Similarly, Nederpel '595 illustrates in Figures 2 and 3 that the niche 13 is not a half-circle. On the other hand, if the niche 13 and the surface 12 (or surface 32) together are considered to be a circular reflector, then Nederpel '595 fails to teach a multi-faceted reflector. Consequently, similar to Ishikawa '572, Nederpel '595 fails to teach **both** a half-circle reflector and a multi-faceted reflector as in pending claims 7 and similarly in claims 1 and 14, and as illustrated in Figures 3 and 4 of the present invention.

**2. No suggestion or motivation exists for combining the cited references**

The Examiner states that "[i]t would have been obvious in the one [sic] skilled in the art at the time the invention was made to combine certain reflector structure to a vehicle stop lamp, since Nederpel et al. teaches that it is known in art to have a reflector and it is necessary structure in vehicle lamp device [sic]." (Office Action, 4.7.2003, p. 6).

Applicants respectfully traverse. Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings. (MPEP § 2144.08). Further, Applicants submit that neither Ishikawa '572 nor

Nederpel '595 suggest to combine a camera reflector structure as taught in Ishikawa '572 with the vehicle stop lamp as taught in Nederpel '595. Each cited reference relied on by the Examiner is entirely directed to different subject matter (*e.g.*, Ishikawa '572 is directed to a camera reflector with a length of only 4mm (Ishikawa '572, Col. 3, line 57 and Col. 5, lines 6-8) and Nederpel '595 is directed toward a vehicle signaling system that has a housing that is 16.5x0.43x0.4in<sup>3</sup> (Nederpel '595, Col. 3, lines 48-63 and Col. 4, line 6)). Certainly, one skilled in the art would not contemplate combining the large structure as taught in Nederpel '595 with the small lamp as taught in Ishikawa '572. An explicit teaching to combine and modify the cited references must be present to establish a *prima facie* case of obviousness, and since this is lacking from Ishikawa '572 and Nederpel '595, then their combination is improper as to render the present claims obvious.

With respect to claims 21-24, Ishikawa '572 clearly does not teach the equations in the claims, nor does Ishikawa '572 suggest such techniques to engineer a reflector. Ishikawa '572 simply does not teach a device with facet locations chosen to create a light distribution pattern that complies with automotive signal lighting requirements, as in claims 21-24.

The Examiner is applying an improper 'obvious to try' rationale in support of the obviousness rejection for claims 21-24. (MPEP § 2145). In some cases, what would have been obvious to try would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the cited reference gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. This is the case here. Ishikawa '572 simply does not teach or suggest the limitations of claims 21-24.

### SUMMARY

In conclusion, it is submitted that Applicants have overcome each of the Examiner's rejections. Therefore, Applicants solicit a notice of allowance.

If for any reason, the application is not considered to be allowable and an interview would be helpful, the Examiner is requested to contact the undersigned at (312) 913-0001.

Respectfully submitted,

**McDonnell Boehnen Hulbert & Berghoff**

Dated: \_\_\_\_\_

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By: \_\_\_\_\_



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